

ESTTA Tracking number: **ESTTA543249**

Filing date: **06/14/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Columbia Insurance Company
Granted to Date of previous extension	06/19/2013
Address	3024 Harney Street Omaha, NE 68131 UNITED STATES

Attorney information	David Chen IP Attorneys Group, LLC 16 Oxford Road, Second Floor Milford, CT 06460 UNITED STATES dchen@ipattorneysgroup.com, trademark@ipattorneysgroup.com, pbucci@ipattorneysgroup.com Phone:2032984830
----------------------	--

Applicant Information

Application No	79115387	Publication date	02/19/2013
Opposition Filing Date	06/14/2013	Opposition Period Ends	06/19/2013
International Registration No.	1122645	International Registration Date	05/22/2012
Applicant	INVESTIMENTI INTERNAZIONALI S.r.l. Via Sicilia, 42 I-00187 ROMA, ITALY		

Goods/Services Affected by Opposition

Class 025. Opposed goods and services in the class: footwear

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1947333	Application Date	12/17/1993
Registration Date	01/09/1996	Foreign Priority Date	NONE
Word Mark	BORN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1994/03/05 First Use In Commerce: 1994/03/05 footwear

U.S. Registration No.	3512409	Application Date	04/02/2008
Registration Date	10/07/2008	Foreign Priority Date	NONE
Word Mark	BORN Å# CROWN		
Design Mark			
Description of Mark	The mark consists of the stylized words "BÅ, rn" and "Crown" surrounding the character "Å#" featuring a crown design inside the character.		
Goods/Services	Class 025. First use: First Use: 2007/06/00 First Use In Commerce: 2007/06/00 Footwear		

U.S. Registration No.	3542937	Application Date	03/04/2008
Registration Date	12/09/2008	Foreign Priority Date	NONE
Word Mark	BORN		
Design Mark			
Description of Mark	The mark consists of the stylized word "BÅ, rn" featuring a crown design inside the letter "o".		
Goods/Services	Class 025. First use: First Use: 1994/06/00 First Use In Commerce: 1994/06/00 Footwear		

Attachments	NOT OF OPP SN 79115387.pdf(508626 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David Chen/
Name	David Chen
Date	06/14/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

COLUMBIA INSURANCE COMPANY

Opposer,

v.

INVESTIMENTI INTERNAZIONALI S.r.l.

Applicant.

Opposition No.: _____

Application SN 79/115,387




Mark:



NOTICE OF OPPOSITION

Opposer, Columbia Insurance Company, a Nebraska Corporation having its principal place of business at 3024 Harney Street, Omaha, NE 68131 ("Opposer"), believes it will be damaged by the allowance and subsequent registration of the mark based upon the application referenced above, and hereby opposes registration thereof pursuant to Section 13 of the Lanham Act, 15 U.S.C. §1063, alleging as grounds for opposition that:

1. Opposer currently uses the trademark **BORN** on or in connection with footwear and other goods.
2. Opposer, through its licensee, markets footwear and other goods in the United States and elsewhere under the trademark **BORN**.
3. Opposer is the owner of the below listed U.S. trademark registrations for its **BORN** marks (attached hereto as the exhibits indicated below are printouts from the TSDR database of Opposer's registrations and made of record in this proceeding pursuant to 37 C.F.R. §2.122(d)(1); hereinafter "Opposer's Marks"):

Mark	Reg. No.	Reg. Date	IC/Goods	TSDR Status
	1,947,333	01/09/1996	IC 025: footwear	Exhibit A
	3,512,409	10/07/2008	IC 025: footwear	Exhibit B
	3,542,937	12/09/2008	IC 025: footwear	Exhibit C

4. The records of the USPTO indicate that Applicant is an Italian limited liability company with an address at Via Sicilia, 42, I-00187 ROMA, Italy.

5. The records of the USPTO indicate that Applicant is the owner of application Serial No. 79/115,387, filed May 22, 2012, for the mark shown above for the following goods ("Applicant's Mark"):

Int'l Class/Goods
IC 025: clothing, namely, bandanas, shirts, sweat suits, underwear, jackets, bathing costumes, beachwear, swimwear, neck bands, capes; footwear; headgear, namely, caps and hats
IC 030: coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour preparations made from cereals, namely, biscuits, tarts and cakes made with cereal, cereal-based snack foods, high-protein cereal bars, cereal-based energy bars not for use as a meal replacement, crackers and processed cereal-based food to be used as a breakfast food, snack food or ingredients for making other food; bread, pastry and confectionery made of sugar; ices; sugar, honey, treacle; yeast and baking-powder; salt; mustard; vinegar; sauces; spices and ice
IC 032: mineral and aerated waters and other non-alcoholic beverages, namely, spring water, sport drinks, sparkling water, smoothies, soft drinks, soda pop, drinking water, energy drinks; fruit beverages and fruit juices; concentrates, syrups or powders used in the preparation of soft drinks; syrups for making beverages
IC 033: alcoholic beverages except beers and wines
IC 034: Tobacco; smoker's articles, namely, ashtrays, cigar and cigarette boxes, cigarette lighter holder, cigar and cigarette lighters not for land vehicles, cigarette rolling paper, filter tips, match boxes, match holders and cigars and cigarettes; matches

6. Applicant filed its application under Section 66(a) of the Lanham Act, 15 U.S.C. §1141(f)(a).

7. Opposer's rights in Opposer's Marks and its common law rights in its **BORN** trademarks are prior in time to any date Applicant is entitled to rely upon in this opposition.

8. Opposer's Registrations Nos. 1,947,333, 3,512,409, and 3,542,937 issued prior to any date Applicant is entitled to rely upon in this opposition.

9. The specific goods "footwear" identified in Class 25 of Applicant's application ("opposed goods") are identical to the goods identified in Opposer's Registrations Nos. 1,947,333; 3,512,409; and 3,542,937.

10. In view of the similarities between Opposer's Marks and Applicant's Mark and the fact that Applicant's opposed goods are identical to Opposer's goods, there is a likelihood that Applicant's opposed goods will be perceived as being sponsored by or affiliated with Opposer.

11. Applicant's Mark so resembles Opposer's Marks, as to be likely to cause confusion, or to cause mistake, or to deceive as to the source of the opposed goods within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

12. The use and registration of Applicant's Mark in connection with the opposed goods will damage Opposer in the advertising and sale of its goods by causing a likelihood of confusion.

WHEREFORE, Opposer prays that the Trademark Trial and Appeal Board deny registration on Application Serial No. 79/115,387 with respect to the opposed goods,

“footwear” in Class 25, and otherwise sustain this opposition with respect to such goods.

Payment in the amount of the required filing fee for opposition in one class is submitted with this Notice of Opposition.

Respectfully submitted,
IP ATTORNEYS GROUP, LLC

Dated: June 14, 2013

By: _____

David Chen
Peter Bucci
16 Oxford Road, 2nd Floor
Milford, CT 06460
Tel: (203) 298-4830
Fax: (203) 298-4832
dchen@ipattorneysgroup.com

Attorneys for Opposer
Columbia Insurance Company

CERTIFICATE OF SERVICE

This hereby certifies that the foregoing **NOTICE OF OPPOSITION** was served via first-class mail, postage prepaid, this 14th day of June, 2013, addressed to Applicant's attorney of record at the address identified in the USPTO records below, with a courtesy copy via email:

John Clarke Holman, Esq.
Jacobson Holman, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
Tel: (202) 638-6666
Fax: (202) 393-5350
trademark@jhip.com



Peter Bucci
IP ATTORNEYS GROUP, LLC
16 Oxford Road, 2nd Floor
Milford, CT 06460
Tel: (203) 298-4830
Fax: (203) 298-4832
pbucci@ipattorneysgroup.com

Attorneys for Opposer
Columbia Insurance Company

Exhibit A

The USPTO is pleased to report that the TSDR problem with the display of mark images has been resolved. Please clear your individual browser cache prior to accessing TSDR. If you continue to experience technical difficulties, [please email](#).

STATUS

DOCUMENTS

[Back to Search](#)

[Print](#)

Generated on: This page was generated by TSDR on 2013-06-14 17:29:44 EDT

Mark: BORN

BØRN

US Serial Number: 74471830

Application Filing Date: Dec. 17, 1994

US Registration Number: 1947333

Registration Date: Jan. 09, 1996

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Mar. 17, 2006

Publication Date: Dec. 06, 1994

Notice of Allowance Date: Feb. 28, 1995

Mark Information

Mark Literal Elements: BORN

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Color(s) Claimed: Color is not claimed as a feature of the mark.

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: footwear

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 05, 1994

Use in Commerce: Mar. 05, 1994

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: COLUMBIA INSURANCE COMPANY

Owner Address: 4016 FARNAM STREET
OMAHA, NEBRASKA 68131
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: NEBRASKA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: David Chen

Docket Number: 00006-T0023

Correspondent

Correspondent Name/Address: David Chen

IP Attorneys Group, LLC
16 OXFORD ROAD, 2ND FLOOR
MILFORD, CONNECTICUT 06460-3823
UNITED STATES

Phone: 203-298-4830

Fax: 203-298-4830

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 22, 2012	ATTORNEY REVOKED AND/OR APPOINTED	
Jun. 22, 2012	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jun. 11, 2007	CASE FILE IN TICRS	
Mar. 17, 2006	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	60132
Mar. 17, 2006	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Mar. 15, 2006	ASSIGNED TO PARALEGAL	60132
Nov. 07, 2005	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	

Nov. 07, 2005	TEAS SECTION 8 & 9 RECEIVED	
Sep. 24, 2002	PAPER RECEIVED	
Jan. 31, 2002	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Dec. 07, 2001	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Jan. 09, 1996	REGISTERED-PRINCIPAL REGISTER	
Oct. 17, 1995	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Oct. 17, 1995	ASSIGNED TO EXAMINER	67604
Sep. 19, 1995	STATEMENT OF USE PROCESSING COMPLETE	
Sep. 19, 1995	EXTENSION 1 GRANTED	
Aug. 25, 1995	USE AMENDMENT FILED	
Aug. 25, 1995	EXTENSION 1 FILED	
Feb. 28, 1995	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Dec. 06, 1994	PUBLISHED FOR OPPOSITION	
Nov. 04, 1994	NOTICE OF PUBLICATION	
Jun. 28, 1994	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 27, 1994	ASSIGNED TO EXAMINER	67604
Jun. 23, 1994	ASSIGNED TO EXAMINER	66593

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jan. 09, 2006

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: SCANNING ON DEMAND

Date in Location: Jun. 11, 2007

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load

Exhibit B

The USPTO is pleased to report that the TSDR problem with the display of mark images has been resolved. Please clear your individual browser cache prior to accessing TSDR. If you continue to experience technical difficulties, [please email](#).

STATUS

DOCUMENTS

[Back to Search](#)

[Print](#)

Generated on: This page was generated by TSDR on 2013-06-14 17:31:09 EDT

Mark: BORN Ø CROWN



US Serial Number: 77438138

Application Filing Date: Apr. 02, 2008

US Registration Number: 3512409

Registration Date: Oct. 07, 2008

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance doc

Status Date: Oct. 07, 2008

Publication Date: Jul. 22, 2008

Mark Information

Mark Literal Elements: BORN Ø CROWN

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the stylized words "Børn" and "Crown" surrounding the character "Ø" featur character.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 24.11.01 - Crowns closed at the top

Related Properties Information

Claimed Ownership of US [1947333](#), [2894288](#), [3093916](#) and others
Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;

- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Footwear

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 2007

Use in Commerce: Jun. 2007

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Columbia Insurance Company

Owner Address: 3024 Harney Street
Omaha, NEBRASKA 68131
UNITED STATES

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** NEBRASKA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: David Chen

Docket Number: 00006-T0380

Correspondent

Correspondent David Chen
Name/Address: IP Attorneys Group, LLC
16 OXFORD ROAD, 2ND FLOOR
MILFORD, CONNECTICUT 06460-3823
UNITED STATES

Phone: 203-298-4830

Fax: 203-298-4830

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 22, 2012	ATTORNEY REVOKED AND/OR APPOINTED	
Jun. 22, 2012	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jun. 21, 2011	CERTIFICATE OF CORRECTION ISSUED	67723
Jun. 21, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	67723
Jun. 16, 2011	TEAS SECTION 7 REQUEST RECEIVED	
Oct. 07, 2008	REGISTERED-PRINCIPAL REGISTER	
Jul. 22, 2008	PUBLISHED FOR OPPOSITION	
Jul. 02, 2008	NOTICE OF PUBLICATION	
Jun. 18, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	78289
Jun. 16, 2008	ASSIGNED TO LIE	78289
Jun. 16, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 12, 2008	ASSIGNED TO EXAMINER	76615
Apr. 08, 2008	NOTICE OF DESIGN SEARCH CODE MAILED	
Apr. 07, 2008	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Change in Registration: Yes

Correction made to In the statement, Column 1, lines 1-4, are deleted, and Columbia Insurance Company (Nebraska
Registration: Omaha Nebraska 68131 should be inserted.

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Aug. 29, 201

[Assignment Abstract Of Title Information - Click to Load](#)

[Proceedings - Click to Load](#)

Exhibit C

The USPTO is pleased to report that the TSDR problem with the display of mark images has been resolved. Please clear your individual browser cache prior to accessing TSDR. If you continue to experience technical difficulties, [please email](#).

STATUS

DOCUMENTS

[Back to Search](#)

Print

Generated on: This page was generated by TSDR on 2013-06-14 17:32:09 EDT

Mark: BORN

Børn

US Serial Number: 77412686

Application Filing Date: Mar. 04, 2008

US Registration Number: 3542937

Registration Date: Dec. 09, 2008

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Dec. 09, 2008

Publication Date: Sep. 23, 2008

Mark Information

Mark Literal Elements: BORN

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the stylized word "Børn" featuring a crown design inside the letter "o".

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 24.11.01 - Crowns closed at the top
26.17.01 - Bars, straight; Lines, straight; Bands, straight; Straight line(s), band(s) or bar(s)
26.17.06 - Bands, diagonal; Bars, diagonal; Diagonal line(s), band(s) or bar(s); Lines, diagonal

Related Properties Information

Claimed Ownership of US [1947333](#), [2894288](#), [3093916](#) and others
Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Footwear

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 1994

Use in Commerce: Jun. 1994

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Columbia Insurance Company

Owner Address: 3024 Harney Street
Omaha, NEBRASKA 68131
UNITED STATES

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** NEBRASKA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: David Chen

Docket Number: 00006-T0027

Correspondent

Correspondent David Chen
Name/Address: IP Attorneys Group, LLC
16 OXFORD ROAD, 2ND FLOOR
MILFORD, CONNECTICUT 06460-3823
UNITED STATES

Phone: 203-298-4830

Fax: 203-298-483

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 22, 2012	ATTORNEY REVOKED AND/OR APPOINTED	
Jun. 22, 2012	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jun. 21, 2011	CERTIFICATE OF CORRECTION ISSUED	68335
Jun. 20, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Jun. 16, 2011	TEAS SECTION 7 REQUEST RECEIVED	
Dec. 09, 2008	REGISTERED-PRINCIPAL REGISTER	
Sep. 23, 2008	PUBLISHED FOR OPPOSITION	
Sep. 03, 2008	NOTICE OF PUBLICATION	
Aug. 21, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	78413
Aug. 21, 2008	ASSIGNED TO LIE	78413
Aug. 14, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 13, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Aug. 13, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Aug. 13, 2008	TEAS RESPONSE TO SUSPENSION INQUIRY RECEIVED	
Jun. 16, 2008	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Jun. 16, 2008	LETTER OF SUSPENSION E-MAILED	6332
Jun. 16, 2008	SUSPENSION LETTER WRITTEN	76615
Jun. 12, 2008	ASSIGNED TO EXAMINER	76615
Mar. 08, 2008	NOTICE OF DESIGN SEARCH CODE MAILED	
Mar. 07, 2008	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Change in Registration: Yes

Correction made to Registration: In the statement, Column 1, line 1, " Delaware " should be deleted, and Nebraska should be ins

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Aug. 29, 201

[Assignment Abstract Of Title Information - Click to Load](#)

[Proceedings - Click to Load](#)